

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

To:

see form PCT/ISA/220

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/IS2004/000002

International filing date (day/month/year)
02.02.2004

Priority date (day/month/year)
10.04.2003

International Patent Classification (IPC) or both national classification and IPC
A61C5/00

Applicant
GLOBODENT EHF.

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☒ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

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Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ in written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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Box No. II Priority

1. ☒ The following document has not been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

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Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application,

☒ claims Nos. 16

because:

☒ the said international application, or the said claims Nos. 16 relate to the following subject matter which does not require an international preliminary examination (*specify*):

see separate sheet

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.

☐ no international search report has been established for the whole application or for said claims Nos.

☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

the written form

☐ has not been furnished

☐ does not comply with the standard

the computer readable form

☐ has not been furnished

☐ does not comply with the standard

☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-*bis* of the Administrative Instructions.

☐ See separate sheet for further details

that when said insert is placed in said cavity the inclination is located at the junction between the exposed surface and an adjacent outer surface of the tooth, allowing insertion of a shapable resin material to form essentially a continuous surface (Fig. 4: there is a gap between the tooth 26 and the inlay). Thus, claim 1 is not novel.

Note that this lack of novelty is a consequence of the lack of clarity of the claim, especially introduced by the term "inclination" (see Item VIII of this written opinion). Nowhere in the prior art a groove or chamfer as described in the drawings appears to be disclosed or even suggested.

----- [dependent claims, negative assessment] -----

Dependent claims 2-15 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty or inventive step, see documents D1 and D2 and the corresponding passages cited in the search report.

Re Item VII

Certain defects in the international application

1. Independent claim 1 is not in the two-part form in accordance with Rule 6.3(b) PCT, which in the present case would be appropriate, with those features known in combination from the prior art (document D1) being placed in the preamble (Rule 6.3(b)(I) PCT) and with the remaining features being included in the characterising part (Rule 6.3(b)(ii) PCT).
2. In order to facilitate the examination of the conformity of the amended application with the requirements of Article 19(2) PCT, **the applicant is requested to clearly identify the amendments carried out**, irrespective of whether they concern amendments by addition, replacement or deletion, **and to indicate the passages of the application as filed on which these amendments are based**. If the applicant regards it as appropriate these indications could be submitted in handwritten form on a copy of the relevant parts of the application as filed.

Re Item III

Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The subject-matter of claim **16** relates to a method of treatment of the human body because the step of "shaping a cavity into which the selected insert will fit" involves a surgical step. Thus, according to Article 34.4(a)(I) and Rule 67.1(iv), no preliminary opinion will be established for those claims.

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following documents:

D1: DE-U-29705583

D2: US5567156

----- [lack of novelty] -----

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims **1-11** is not new in the sense of Article 33(2) PCT.

The document **D1** discloses (the references in parentheses applying to this document):

A pre-formed tooth insert for insertion in a prepared cavity in a tooth, wherein

a. said insert has at least one surface that remains exposed when the insert is placed in the prepared cavity (Fig. 8),

b. said insert has a contact surface in continuation of the exposed surfaces, which contact surface comes in contact with the inner surface of the prepared tooth cavity when the insert is placed in the cavity, said contact surface forming substantially vertical edges at the junction with said exposed surface (Fig. 1: edges between exposed front surface and rear contact surface, i.e. the dashed transition region between region 10 and 12, are indeed *substantially* vertical),

c. each of said substantially vertical edges, having an inclination along at least a portion of the edge (Fig. 1: the rounded portions of U-shaped item 10 have an inclination) such

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Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	12-15
	No: Claims	1-11
Inventive step (IS)	Yes: Claims	
	No: Claims	12-15
Industrial applicability (IA)	Yes: Claims	1-15
	No: Claims	

2. Citations and explanations

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

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3. Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in the documents D1 is not mentioned in the description, nor is this document identified therein.

Re Item VIII

Certain observations on the international application

The present application does not fulfill the requirements of Article 6 PCT because claims **1, 5, and 6** are not clear. The term "inclination" is usually used in order to describe a slope, not a chamfer, which appears to be intended in the present application.